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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,977	01/26/2004	Curt D. Seymour	70026970-0011	9301

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EXAMINER
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HOGUE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

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07/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,977	<b>Applicant(s)</b> SEYMOUR ET AL.	
	<b>Examiner</b> Gary C. Hoge	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION*****Election/Restrictions***

1. This application discloses three inventions: A method of manufacturing a spacer (claim 12), an insert for the cover of a photo album (Figs. 4-6), and a picture frame/shadow box (Figs. 7-9). In the response filed September 17, 2007, Applicant elected the picture frame (Figs. 7-9). Applicant asserted that claim 12 is directed to non-elected subject matter and that claims 1-11 and 13-17 are directed to the elected subject matter. The Examiner agrees that claim 12 is directed to non-elected subject matter and that claims 8-11 and 13-17 are drawn to the elected subject matter. However, the Examiner disagrees with Applicant's assertion that claims 1-7 are drawn to the elected subject matter. Therefore, in accordance with MPEP § 821, the Examiner holds claims 1-7 as not being directed to the elected subject matter, and withdraws them from further consideration. The reasons for the Examiner's holding are as follows: The independent claim of this group, claim 1, uses terminology that is only used in the specification to describe the non-elected subject matter (i.e., that illustrated in Figs. 4-6):

1. A custom display and storage system comprising: a display unit (page 11, line 11) having an opening (page 12, line 8), said opening adapted for display of an image or character string (page 12, line 8); a customizable insert assembly (page 12, lines 4 and 5) adapted for display of an image or character string (page 12, lines 7-9), said insert assembly including a matting (page 12, line 7), said matting including a cut out corresponding to said opening of said display unit, said cut out being smaller than said opening (page 13, lines 6-9); a releasable connection between said display unit and said insert assembly adapted to removably mount said insert assembly to said display unit (page 14, lines 11-13), and a storage unit (i.e., a photo album) coupled with said display unit.

This terminology is *not* used to describe the elected subject matter (see page 15, line 11, through page 16, line 11). Further, in no way can the elected subject matter (the picture frame illustrated in Figs. 7-9) be construed to contain "a customizable insert assembly adapted for

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display of an image or character string, said assembly including a matting, said matting including a cut out corresponding to said opening of said display unit, said cut out being smaller than said opening,” or “a releasable connection between said display unit and said insert assembly adapted to removably mount said insert assembly to said display unit,” or “a storage unit coupled with said display unit,” as recited in claim 1. It is clear that claims 1-7 are explicitly drawn to the non-elected subject matter, they do not and cannot read on the elected subject matter, and they are therefore properly withdrawn from further consideration.

2. Claims 1-7 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and invention, respectively, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 17, 2007.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8, 9 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Royal (5,383,293).

Royal discloses a display system comprising a frame **11** having a lip; a transparent display panel **12** supported within a front side of the frame by the lip (Fig. 3); a single piece spacer **13** positioned within the frame on an opposite side of the panel to the lip; a backing **17**, **20** positioned on an opposing side of the spacer to the panel, the backing adapted to maintain the

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spacer and the panel within the frame from a back side of the frame and wherein the backing generally extends across the entire center of the frame to provide an enclosed space within the frame between the panel and the backing.

Regarding claim 9, the backing comprises a matting component **18** and a backing component **20**.

Regarding claim 13, see Figs. 10 and 11, and column 8, lines 31-34.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royal (5,383,293).

Regarding claim 10, the spacer disclosed by Royal is slightly narrower than the lip, but it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to make the spacer similar in width to the lip because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 11, the spacer disclosed by Royal has an inner circumference that is smaller than the outer circumference of the lip. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inner circumference of the spacer similar to the outer circumference of the lip because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

8. Applicant's arguments with respect to the claim have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary C. Hoge/  
Primary Examiner, Art Unit 3611